SUNWAY BIG BOX SDN BHD v. BIG BOX CORPORATION PTE LTD

HIGH COURT MALAYA, KUALA LUMPUR
AZLAN SULAIMAN JC
[ORIGINATING SUMMONS NO: WA-24IP-15-07-2022]
6 DECEMBER 2022

Abstract – *Whether or not goods or services under a trademark had been used in the course of trade could only realistically and reasonably be established by conducting an empirical market survey of the marketplace. Should an applicant wish to use any alternative to the usual market survey, it should be a viable alternative. Desktop internet searches and checks alone cannot possibly prove non-use of goods in the course of trade in Malaysia.*

INTELLECTUAL PROPERTY: *Trademarks – Application for order to revoke and declare trademark as invalid – Whether applicant established itself as aggrieved person – Whether goods or services in respect of which trademark was registered had not been put to use in good faith in Malaysia or had been suspended for uninterrupted period of three years – Whether registered proprietor could show use during those three-year periods or proper reasons for non-use*

In the present application, the plaintiff sought an order that, *inter alia*, the defendant's trademark no. 05001478 for 'Big Box' in Class 35 ('defendant's trademark') be revoked and declared invalid from the Register of Trademarks, Malaysia. In support of its application, the plaintiff submitted that: (i) the plaintiff was a member of the Sunway Group, one of the largest conglomerates in Malaysia and a household name; (ii) Sunway Berhad had applied for and was successfully registered as the owner of several trademarks bearing the word 'Sunway' in Class 35; (iii) three subsequent applications by the plaintiff in 2021 to register its trademarks, in Classes 35 and 43, were provisionally refused by the Registrar; (iv) the plaintiff's trademarks had become well-known trademarks; (v) the plaintiff had used the plaintiff's trademarks earlier than the defendant's trademark; (vi) the continued registration of the defendant's trademark would prejudice the plaintiff and would impede the use of the plaintiff's trademarks; and (vii) the continued registration of the defendant's trademark would cause confusion and/or deception to the Malaysian public. The defendant's case was that: (i) the defendant's application to register the defendant's trademark was initially refused because of two existing registered marks, both using the word 'bigboXX.com'; (ii) however, these trademarks were removed from the Register on 26 September 2014 when their owner did not apply to renew them; and (iii) on 6 April 2016, the defendant's trademark was then accepted

for registration, gazetted on 27 October 2016 and the certificate of registration for it was issued on 6 February 2017 and remained valid until 31 January 2025 but could be renewed.

Held (dismissing application):

(1) The words in s. 46(1) of the Trademarks Act 2019 suggested three stages of enquiry when dealing with an application under the said section, with each stage having to be successfully navigated before moving on to the next. The first stage is to inquire and determine whether the applicant is a person aggrieved by the trademark it seeks to revoke. If the applicant establishes that it is an aggrieved person, then the court would move on to the second stage which would be to inquire whether the goods or services in respect of which the trademark was registered had not been put to use in good faith in Malaysia or had been suspended for an uninterrupted period of three years. The applicant bears the burden of proving the first and second stages. If the applicant is able to navigate through the second stage, the court would move on to the third stage where the burden would shift to the registered proprietor to either show use during those three-year periods or proper reasons for non-use. If he is able to show either, then his trademark would remain intact and the application to remove it would be dismissed. (paras 13-17)

(2) The plaintiff had not established that it was an aggrieved person for the following reasons: (i) the plaintiff failed to adduce any evidence (a) to substantiate its connection with the Sunway Group or Sunway Berhad, including searches with the Companies Commission of Malaysia. Simply because its name had the word 'Sunway' did not *ipso facto* mean that it was part of the Sunway Group. This was not something that the court could simply assume; (b) to substantiate its contention that the plaintiff's trademarks had become well-known trademarks; (c) of actual use of the plaintiff's trademarks *ie* photographs, invoices *etc*; (d) of any genuine and present intention to use the plaintiff's trademarks as a trade mark in the course of trade which was the same as or similar to that of the defendant; and (e) of use of the plaintiff's trademarks prior to the defendant's trademark; (ii) the documents the plaintiff adduced on the Registrar's provisional refusal of the plaintiff's trademarks did not state the grounds for those refusals. They certainly did not state that those refusals were because of the defendant's marks; and (iii) apart from making a bare allegation that the continued registration of the defendant's trademark would cause confusion and/or deception to the Malaysian public, the plaintiff did not descend to particulars or adduce any evidence to support that. (para 28)

Obiter:

(1) The plaintiff attempted to do away with a market survey based on the Whitford Guidelines and supplanted it with its investigator's 'Desktop Searches and Checks'. Whether or not there was use of goods or services bearing the defendant's trademarks in the course of trade in Malaysia could only realistically and reasonably be established by conducting a market survey of the marketplace in Malaysia. Internet searches alone could not do that. (paras 1, 2 & 46)

Case(s) referred to:

E-Toyo Global Stationery Sdn Bhd v. Toyo Ink Sdn Bhd & Anor [2004] 7 CLJ 368 HC ***(refd)***

Imperial Group Plc v. Philip Morris Ltd [1984] RPC 293 ***(refd)***

Lam Soon Edible Sdn Bhd v. Hup Seng Perusahaan Makanan (M) Sdn Bhd [2010] 5 CLJ 975 HC ***(refd)***

Lim Yew Sing v. Hummel International Sports & Leisure A/S [1996] 4 CLJ 784 CA ***(refd)***

Liwayway Marketing Corporation v. Oishi Group Public Co Ltd [2017] 5 CLJ 133 FC ***(refd)***

Liwayway Marketing Corporation v. Oishi Group Public Company Ltd [2017] 2 CLJ 286 CA ***(refd)***

Marks and Spencer Plc v. Interflora Inc & Anor [2012] EWCA Civ 1501 ***(refd)***

McLaren International Ltd v. Lim Yat Meen [2009] 4 CLJ 749 FC ***(refd)***

Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party) [2015] 9 CLJ 125 FC ***(refd)***

Re Arnold D Palmer In The Matter Of Trade Mark Registration No 63249 [1986] 1 LNS 11 ***(refd)***

Legislation referred to:

Rules of Court 2012, O. 87 r. 2

Trademarks Act 2019, ss. 7(1), (2), 17(1)(a), 36(2), (3), 46(1)(a), (b), 47, 53(a), (b), (c)

For the plaintiff - Ng Lih Jun; M/s Rosli Dahlan Saravana Partnership

Reported by Najib Tamby

JUDGMENT

Azlan Sulaiman JC:

Whitford J Would Be Mortified

[1] Sir John Norman Keates Whitford, a British barrister, judge, and intellectual property specialist, was a High Court Judge in the Chancery Division from 1970 to 1988. In May 1984, in *Imperial Group Plc v. Philip Morris Ltd* [1984] RPC 293, Whitford J set out what are generally accepted as the proper guidelines for the conduct of surveys for trademark matters; hence they are attributed to and named after him.

[2] All of that information can be gleaned from a simple desktop search on Whitford J. However, Whitford J would be mortified at the plaintiff's attempt here do away with a market survey based on his guidelines and supplant it with its investigator's "Desktop Searches & Checks". But I must stress that his mortification alone was not the only reason I dismissed the plaintiff's application.

The Plaintiff's Application

[3] On 26 July 2022, the plaintiff filed this originating summons ("the plaintiff's application") for an order, *inter alia*, that the defendant's Trademark No. 05001478 for BIG BOX Class 35 ("the defendant's trademark") be revoked and declared invalid from the Register of Trademarks, Malaysia.

[4] In order to cast its net as wide as possible and in an effort to leave no legislative stone uncovered, in the intitulement of the plaintiff's application the plaintiff cited many sections of the Trademarks Act 2019 ("the Act") "and other relevant provisions under the Trademarks Act 2019 (Act 815) and the Trademarks Regulations 2019". For good measure, it also included and did the same with the Trade Marks Act 1976 and the Trade Marks Regulations 1997 even though both have been repealed and superseded by its 2019 brethren.

[5] Given that the plaintiff's application seeks to revoke and invalidate the defendant's trademark, I will take it that the plaintiff's application primarily invokes ss. 46 and 47 of the Act, which are for those exact purposes.

The Defendant's Trademark

[6] The defendant applied to register the defendant's trademark on 31 May 2005.

[7] In its "Pernyataan Bertulis" regarding the registration of the defendant's trademark, the Registrar of Trademarks ("the Registrar") stated, *inter alia*:

(i) the defendant's application to register the defendant's trademark was initially refused because of two existing registered marks Nos. 00005917 and 00005918, both using the word "bigboXX.com";

(ii) however, those trademarks were removed from the Register on 26 September 2014 when their owner did not apply to renew them; and

(iii) on 6 April 2016, the defendant's trademark was then accepted for registration. It was gazetted on 27 October 2016, and the certificate of registration for it was issued on 6 February 2017. It is valid until 31 January 2025, but can be renewed.

[8] The defendant's trademark is registered in Class 35, for:

> The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers in retail shops, supermarkets, hypermarkets, convenience stores, wholesale outlets, factory outlets, warehouse retail outlets, retail outlets and big department stores, to conveniently view and purchase those goods; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site or by means of telecommunication; compilation of mailing lists; mail, telephone and all other communication and telecommunication ordering services;
>
> Direct mail advertising; business advisory and business services; advertising services; display services for merchandise; publicity services; marketing and promotional services; market analysis and research; import-export agency services; procurement and buying of goods on behalf of a business; window dressing; sales and distribution services; electronic.

The Plaintiff's Application *Vis A Vis* S. 46(1) Of The Act

[9] Section 46(1)(a) and (b) of the Act, under the heading "Revocation of registration by court as to non-use of trademark", provide:

> (1) The registration of a trademark may be revoked by the Court on an application by an aggrieved person on any of the grounds as follows:
>
> (a) where within a period of three years following the date of issuance of the notification of registration, the trademark has not been put to use in good faith in Malaysia, by the registered proprietor or with his consent, in relation to the goods or services for which the trademark is registered, and there are no proper reasons for non-use;
>
> (b) where the use of the goods or services under paragraph (a) has been suspended for an uninterrupted period of three years, and there are no proper reasons for non-use;

[10] Under limb (a), the three-year period of non-use in good faith of a trademark is pegged to the "notification of registration". Under s. 36(2) of the Act, the Registrar issues such notification of registration to the successful applicant/proprietor. Under s. 36(3) of the Act, a certificate of registration is equivalent to the notification of registration issued under s. 36(2). As I said earlier, the certificate of registration for the defendant's trademark is dated 6 February 2017.

[11] Thus, for the purpose of limb (a), the plaintiff would have to show non-use of the defendant's trademark in good faith for the period of three years from 6 February 2017 to 6 February 2020.

[12] For limb (b), the plaintiff takes the position that the use of the goods or services under limb (a) has been suspended from 26 July 2019 to 26 July 2022, being the three-year period leading up to the date the plaintiff filed the plaintiff's application on that later date.

The Three Stages Of Inquiry For An Application Under S. 46

[13] The words of s. 46(1) suggest three stages of enquiry when dealing with an application thereunder, with each stage having to be successfully navigated before moving on to the next.

[14] The first stage is to inquire and determine whether the applicant is a person aggrieved by the trademark it seeks to revoke. The applicant bears the burden of proving that. If it does not, then the matter would end there, and its application would be dismissed without further inquiry.

[15] If the applicant does establish that it is an aggrieved person, then we would move on to the second stage, which would be to inquire whether the goods or services in respect of which the trademark was registered had not been put to use in good faith in Malaysia, or had been suspended for an uninterrupted period of three years. Again, the applicant bears the burden of proving that, on a *prima facie* basis.

[16] If the applicant fails to do so, then the registered proprietor of the trademark is not even called upon to establish use. This was decided in several cases, including *E-Toyo Global Stationery Sdn Bhd v. Toyo Ink Sdn Bhd & Anor* [2004] 7 CLJ 368, *Lam Soon Edible Sdn Bhd v. Hup Seng Perusahaan Makanan (M) Sdn Bhd* [2010] 5 CLJ 975; [2010] 4 MLJ 702 and *Liwayway Marketing Corporation v. Oishi Group Public Company Ltd* [2017] 2 CLJ 286, and I see no reason to depart from them.

[17] If the applicant is able to navigate through that second stage by establishing, *prima facie*, that the use of the goods or services in respect of which the proprietor's mark was registered had not been used since registration and/or had been suspended for an uninterrupted period of three years, we would then move on to the third stage. In that third stage, the burden would shift to the registered proprietor to either show use during those three-year periods, or proper reasons for non-use. If he is able to show either, then his trademark would remain intact and the application to remove it would be dismissed.

[18] Conversely, if the registered proprietor is unable to show either use during those periods of three years or any proper reasons for non-use, then the application would be allowed and the registration of his trademark would be removed from the Register.

[19] Before proceeding to the first stage, I have duly noted that the defendant did not either enter an appearance to the plaintiff's application or affirm affidavits or submissions opposing it, despite this court's order of 6 September 2020 for service of it out of jurisdiction on the defendant in Singapore, and the subsequent service as affirmed by an affidavit of service of the process server.

[20] Nevertheless, that non-opposition to the plaintiff's application does not of itself absolve the plaintiff from the burden of establishing that it is a person aggrieved and of that *prima facie* non-use for three years. The court still has to be convinced of that.

First Stage: Whether The Plaintiff Is An Aggrieved Person

[21] In *Re Arnold D Palmer In The Matter Of Trade Mark Registration No 63249* [1986] 1 LNS 11; [1987] 2 MLJ 681, after reviewing several English authorities, Chan Sek Keong J (as His Lordship then was) said:

> On the basis of these decisions, it is plain that the applicant will fail in this appeal unless he can show that he has used his trade mark in the course of a trade which is the same as or similar to that of the respondents or that he has a genuine and present intention to use the mark as a trade mark.

[22] In approving that passage, Abdul Aziz Mohamad FCJ said in *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749:

> We understand that passage as laying down the principle that a person aggrieved is a person who has used his mark as a trade mark – or who has a genuine and present intention to use his mark as a trade mark – in the course of a trade which is the same as or similar to the trade of the owner of the registered trade mark that the person wants to have removed from the register.

[23] Then, in *Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party)* [2015] 9 CLJ 125; [2015] 6 MLJ 465, Azahar Mohamed FCJ (later CM (Malaya), said:

> A person aggrieved is a person who has used his mark as a trade mark or who has a genuine and present intention to use his mark as trade mark in the course of a trade which is the same as or similar to the registered trade mark that the person wants to be removed from the register. The person must be someone who has some element of legal interest, right or legitimate expectation in its own mark which is being substantially affected by the presence of the registered trade mark. The interest and right must be legal or lawful.

[24] In short, the applicant has used his trade mark or has a genuine and present intention to use his mark as a trade mark in the course of a trade which is the same as or similar to that of the respondents.

[25] Based on the sole affidavit affirmed by the plaintiff's Senior Group Manager of Brand, Marketing & Communication ("the plaintiff's affidavit"), the plaintiff's contentions for being an aggrieved person under s. 46(1) of the Act include the following:

(i) The plaintiff is a member of the Sunway Group, one of the largest conglomerates in Malaysia and a household name, that is engaged in business over a wide range of industries, including real estate, construction, education, healthcare, retail and hospitality.

(ii) Sunway Berhad has applied for and been successfully registered as owner of several trademarks bearing the word "Sunway" all in Class 35. The details of the eight the plaintiff adduced are in Table A below:

Table A

Application No.	Date	Certificate of registration
00000906	31.1.2000	16.5.2003
06009617	5.6.2006	21.7.2009
09010630	26.6.2009	9.3.2011
2013051581	25.2.2013	20.3.2014
2013051583	25.2.2013	20.3.2014
2014050008	2.1.2014	18.3.2015
2014055402	14.4.2014	4.9.2015
2016009074	24.8.2016	28.4.2017

(iii) Three subsequent applications by the plaintiff in 2021 to register its trademarks, in Classes 35 and 43 were provisionally refused by the Registrar. The details of the plaintiff's trademarks are in Table B below:

Table B

Application No.	Date	Trademark
TM2021011506	21.4.2021	"Sunway Hotel Big Box"
TM2021011507	21.4.2021	"Sunway Big Box"
TM2021011512	14.4.2022	"Big Box"

(iv) The plaintiff's trademarks have become well-known trademarks;

(v) The plaintiff has used the plaintiff's trademarks earlier than the defendant's trademark;

(vi) The continued registration of the defendant's trademark would prejudice the plaintiff and would impede the use of the plaintiff's trademarks; and

(vii) The continued registration of the defendant's trademark would cause confusion and/or deception to the Malaysian public.

[26] Despite these averments, there are several reasons why I would hold that the plaintiff has not established that it is an aggrieved person.

[27] Under O. 87 r. 2 of the Rules of Court 2012, applications to the court under the Act – which would necessarily include applications under ss. 46 and 47 of the Act – "shall be begun by originating summons." This means that an applicant under s. 46 must discharge the burden of proving it is an aggrieved person and of non-use by the affidavits it files in support of its originating summons.

[28] The plaintiff's affidavit falls far short of that:

(i) Firstly, the plaintiff failed to adduce any documents (including searches with the Companies Commission of Malaysia) to substantiate its connection with the Sunway Group or with Sunway Berhad. Simply because its name has the word "Sunway" in it does not *ipso facto* mean it is part of the Sunway Group. It is not something that the court can simply assume.

(ii) Secondly, the plaintiff failed to adduce any evidence to substantiate its contention that the plaintiff's trademarks have become well-known trademarks. The eight trademarks listed in Table A above belong to Sunway Berhad, and those may have become well-known. But Sunway Berhad and the plaintiff are separate legal entities. Those trademarks are not the plaintiff's.

(iii) Thirdly, the plaintiff did not adduce any evidence of actual use of the plaintiff's trademarks. Photographs, invoices, *etc* showing use would have been helpful.

(iv) Fourthly, nor was there any evidence of any genuine and present intention to use the plaintiff's trademarks as a trademark in the course of a trade which is the same as or similar to that of the defendant. I have ser out earlier the goods and services of Class 35 for which the defendant's trademark was registered. Which of those trades the plaintiff is involved in is anyone's guess.

(v) Fifthly, the plaintiff did not adduce any evidence of use of the plaintiff's trademarks prior to the defendant's trademark.

(vi) Sixthly, the documents the plaintiff adduced on the Registrar's provisional refusal of the plaintiff's trademarks do not state the grounds for those refusals. They certainly do not state that those refusals were

because of the defendant's marks. Consequently, the plaintiff failed to back-up its statement that "the continued registration of the defendant's trademark would prejudice the plaintiff and would impede the use of the plaintiff's trademarks"'; and

(vii) Lastly, apart from making a bare allegation that "The continued registration of the defendant's trademark would cause confusion and/or deception to the Malaysian public", the plaintiff did not descend to particulars or adduce any evidence to support that.

[29] I would accordingly hold that the plaintiff has failed to establish that it is aggrieved by the defendant's mark. In short, it is not an aggrieved person.

[30] Even though I had stated earlier that the plaintiff's failure to establish it is an aggrieved person would result in the matter ending there and the plaintiff's application be dismissed, I will still go on to the second stage to explain why I believed the plaintiff has also fallen short of that too.

Second Stage: Whether There Had Been Non-use Or Suspension For Three Years Of The Goods Or Services In Respect Of Which The Defendant's Mark Was Registered

[31] As I had mentioned earlier, for the second stage of inquiry, the plaintiff must prove on a *prima facie* basis, that the goods or services in respect of which the defendant's trademark was registered had not been put to use in good faith in Malaysia within three years of the certificate of registration, or have been suspended for an uninterrupted period of three years.

[32] Under s. 7(1) and (2) of the Act:

> (1) References to the use of a trademark shall be construed as references to the **use of a printed or other visual or non-visual representation of the trademark.**
>
> (2) References to the use of a trademark in relation to goods shall be construed as reference to the use of the trademark **upon, or in physical or other relation to, the goods.** (emphasis added)

[33] Under s. 17(1)(a) of the Act, only a person who claims to be a *bona fide* proprietor of a trademark may apply to register it "if the person **is using or intends to use the trademark in the course of trade**". (emphasis added)

[34] In *Mesuma Sports Sdn Bhd* (*supra*), Azahar Mohamed FCJ said:

> ... The common law ownership to a trademark requires the claimant establishing its entitlement to it not by showing that it is the creator of the identifier but rather, by reason of its use as a trademark on goods **in the course of its trade.** (emphasis added)

[35] Logically speaking, whether or not goods or services under a trademark has been used in the course of trade could only realistically and reasonably be established by conducting a market survey in the marketplace. And it is in the conduct of a survey that the Whitford Guidelines become relevant.

The Whitford Guidelines

[36] In *Marks and Spencer Plc v. Interflora Inc & Anor* [2012] EWCA Civ 1501, the Court of Appeal summarised the "Whitford Guidelines". They are:

(i) If a survey is to have any validity at all, the way in which the interviewees are selected must be established as being done by a method such that a relevant cross-section of the public is interviewed;

(ii) any survey must be of a size which is sufficient to produce some relevant result viewed on a statistical basis;

(iii) the party relying on the survey must give the fullest possible disclosure of exactly how many surveys they have carried out, exactly how those surveys were conducted and the totality of the number of persons involved, because otherwise it is impossible to draw any reliable inference from answers given by a few respondents;

(iv) the questions asked must not be leading; and must not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put;

(v) exact answers and not some sort of abbreviation or digest of the exact answer must be recorded;

(vi) the totality of all answers given to all surveys should be disclosed; and

(vii) the instructions given to interviewers must also be disclosed.

[37] Our courts have seen the rationale and wisdom in applying the Whitford Guidelines. See, amongst others, *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 4 CLJ 784, *Lam Soon Edible Sdn Bhd v. Hup Seng Perusahaan Makanan (M) Sdn Bhd* [2010] 5 CLJ 975 and *Liwayway Marketing Corporation v. Oishi Group Public Co Ltd* [2017] 5 CLJ 133.

[38] In *Lim Yew Sing v. Hummel International Sports & Leisure A/S* (*supra*), Mahadev Shankar JCA said that the Whitford Guidelines are the minimum criteria to be met for survey evidence to have credibility.

[39] Here, the plaintiff did not even conduct or commission a market survey. Instead, the plaintiff seeks to establish that non-use by a 12-page document entitled *"Investigation BIG BOX June 2022"* ("the report"). The report alleges, *inter alia*:

(i) that the plaintiff's previous solicitors had issued instructions for the conduct of an investigation on the defendant and the defendant's trademark;

(ii) that under Stage A (and the report does not speak of a Stage B or any other stages), the recipient of that instructions was "To conduct Desktop Searches & Checks to confirm that there is indeed no physical presence and use of the mark BIG BOX by the Registrant in Malaysia";

(iii) that, based on various desktop searches and checks "there is no indication of the usage of the mark BIG BOX by the Registrant in Malaysia";

(iv) apart from the use of the Sunway Big Box for a shopping mall and website operated by the Sunway Group, three other websites operated by Big Box Asia, Shoppee and Big Box Ventures (which was not related to the defendant) used the mark BIG BOX;

(v) based on the desktop searches conducted, there was no sighting of the usage of the mark BIG BOX by the defendant in Malaysia;

(vi) from the checks conducted, the defendant operated a website https://zeppbigbox.com.sg//. However, the shopping mall in Singapore had been sold;

(vii) an internet search for the defendant's contact number was also unsuccessful;

(viii) a newspaper report in the Straits Times on 11 September 2018 stated, *inter alia*:

(a) that Big Box Singapore is an indirect wholly owned subsidiary of TT International Limited;

(b) that Big Box Singapore had initiated a creditor's voluntary liquidation proceedings on 11 September 2018;

(c) that one Abuthahir Abdul Gafoor of AAG Corporate Advisory had been appointed its liquidator.

[40] In the plaintiff's affidavit, the plaintiff's Senior Group Manager of Brand, Marketing & Communication said of the report, *inter alia*:

(i) the defendant's trademark was not found to be in use in Malaysia;

(ii) there is no evidence that the defendant's services bearing the defendant's trademark was or is being sold/supplied in Malaysia;

(iii) there is no use of the defendant's trademark in the course of the defendant's trade.

[41] At the hearing of the plaintiff's application, I asked counsel for the plaintiff if the plaintiff had any particular reason for not conducting a market survey. She informed me that her client's practice is to first conduct internet searches on the registered proprietor of the trademark and the trademark they are seeking to challenge, for any trade activities for the goods or services bearing the defendant's trademark and only conduct a survey if there were. As the internet searches did not reveal any, the plaintiff did not conduct a market survey. The plaintiff's position, she informed me, was that the contents of the report was sufficient on its own to support its case for the plaintiff's application.

[42] I do not agree. In my opinion, the report is wholly inadequate in determining whether or not the goods and services for which the defendant's trademark was registered had or had not been put to use in good faith in Malaysia within three years of the certificate of registration, or has been suspended for an uninterrupted period of three years. Further, the report is not an adequate substitute for a market survey. I have several reasons for saying so.

[43] Firstly, the report is not even signed and its authorship unknown. Though a logo with the word "dnarisk" appears at the bottom left-hand corner of each page, who that is or what that represents is nowhere to be seen. On this score alone, I would reject the report.

[44] In *Lim Yew Sing v. Hummel International Sports & Leisure A/S* (*supra*), Mahadev Shankar JCA rejected the survey for those same reasons, saying:

> ... this survey was nothing more than hearsay evidence, and Shriver's averments thereon were hearsay upon hearsay. Since it was contested it was incumbent upon the respondent to prove its contents as required by the Evidence Act. Since nobody had been called from In-Depth to prove the survey it was not evidence as that word is understood in a Court of law because it was not admissible.

[45] Secondly, all that information in the report on Big Box Singapore, TT International Limited, the website https://zeppbigbox.com.sg// and the shopping mall in Singapore is wholly irrelevant to the question of whether the goods or services in respect of which the defendant's trademark was registered had not been put to use in good faith in Malaysia.

[46] Thirdly, desktop searches and checks alone cannot possibly prove non-use of goods in the course of trade in Malaysia. The maker of the report only said that, based on the desktop searches there is "no indication of the usage"' and "no sighting of the usage" of the defendant's trademark in Malaysia. How can that be conclusive? Logically speaking, whether or not there was use of goods or services bearing the defendant's trademark in the course of trade in Malaysia could only realistically and reasonably established by conducting an empirical market survey of the marketplace in Malaysia. Internet searches alone cannot do that.

[47] Fourthly, even though the Act does not expressly require a market survey to be carried out to establish such use in Malaysia, should the plaintiff wish to use any alternative to the usual market survey, it should be a viable alternative. As our courts have long accepted surveys being conducted, I would think that any such applicant should explain why it decided not to do a survey and why it decided to engage that alternative, and further explain why its alternative was comparable in yielding the same results as a market survey would. Here, the plaintiff's affidavit gave no explanation and the plaintiff's counsel's explanation merely explained the plaintiff's unilateral election not to do one after the internet search.

[48] Lastly, the defendant applied to register the defendant's trademark on 31 May 2005, it was accepted on 6 April 2016, and the certificate of registration for it was issued on 6 February 2017. That was more than five years before the plaintiff's application. Under s. 53 of the Act, it is taken to be valid in all respects unless any of limbs (a), (b) or (c) can be shown. That suggests to me that the revocation of it under s. 46 cannot be done on willy-nilly and only after the applicant has discharged the burden the Act places on it.

[49] All of these shortcomings with the report render the averments about it in the plaintiff's affidavit questionable.

[50] I would therefore dismiss the plaintiff's application to revoke the defendant's trademark under s. 46(1) of the Act.

The Plaintiff's Application *Vis-A-Vis* S. 47 Of The Act

[51] The plaintiff's application *vis-a-vis* s. 47 of the Act fares no better.

[52] Section 47 of the Act is for invalidation of trademarks by the court. It expressly provides:

> (1) The registration of trademark may be declared invalid by the Court upon the application by an aggrieved person on the ground that the trademark was registered in breach of section 23.
>
> (2) Notwithstanding subsection (1), where the trademark was registered in breach of paragraph 23(1)(b), (c) or (d), it shall not be declared invalid if, the registration of trademark has acquired a distinctive character after its registration in consequence of its use in relation to the goods or services for which it is registered.
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> (3) The registration of trademark may be declared invalid by the Court upon the application by an aggrieved person on the ground that:
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> (a) there is an earlier trademark under subsection 24(1), (2) or (3); or
>
> (b) there is an earlier right under subsection 24(4).

(4) The registration of trademark may not be declared invalid under subsection (3) if the proprietor of that earlier trademark or earlier right has consented to the registration.

(5) Where a trademark has been registered on the ground that there has been an honest concurrent use of the trademark and the earlier trademark or other earlier right, as provided for by section 25, the registration of trademark may not be declared invalid under subsection (3) unless the Registrar or the Court is satisfied that in fact there had been no honest concurrent use of the trademark and the earlier trademark or other earlier right

(6) The registration of trademark may be declared invalid by the Court upon the application by an aggrieved person or the Registrar on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

(7) Where the ground of invalidity exists in respect of only some of the goods or services for which the trademark is registered, the trademark shall be declared invalid as regards those goods or services only.

(8) Where the registration of trademark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, but this shall not affect transactions past and closed.

[53] In the plaintiff's affidavit, the plaintiff's Senior Group Manager of Brand, Marketing & Communication did not depose to any of grounds for invoking s. 47 of the Act, apart from those same reasons it contends it is an aggrieved person.

[54] For the reasons I set out in paragraph above, I also reject the plaintiff's application *vis-a-vis* s. 47 of the Act. In my opinion, those same grounds show that the plaintiff is not an aggrieved person, and does not justify any of the grounds for invalidating the defendant's trademark under s. 47 of the Act.

Conclusion

[55] For these grounds, I dismissed the plaintiff's application, but made no order as to costs because of an absent defendant.